



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,665	03/11/2004	E. Marlowe Goble	13447.43	6304
22913	7590	10/09/2007		
WORKMAN NYDEGGER 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			EXAMINER COMSTOCK, DAVID C	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 10/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/798,665

Applicant(s)

GOBLE ET AL.

Examiner

David Comstock

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-64, 92 and 93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-64, 92 and 93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/05, 8/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, containing claims 35-64, 92 and 93, in the reply filed on 17 August 2007 is acknowledged. No claims have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim, because Applicant canceled claims 75-85, directed to the nonelected invention. The remaining non-elected claims were previously canceled. Accordingly, claims 35-64, 92 and 93 are pending in the application.

### ***Claim Objections***

In claim 35, line 8, "faster" should be changed to --fastener--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-41, 43-45, 48-53, 55, 57-64, 92 and 93 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (4,673,407; cited by Applicant).

Martin discloses a tibial implant comprising a body with an articular surface 29 and a bone apposition surface. See, e.g., Figs. 6 and 9. A tray 64 retains a polymeric bearing plate 62. The device comprises articular surfaces with a track and key shape (see, e.g. Fig. 1 and 6, showing complementary track surface with a central key portion). A means for securing a fastener comprises a socket 90 formed on a stem extending from the bone apposition surface of the body. The stem extends at an angle of 90 degrees which is "about" 80 degrees. The articular surface is selectively connected to the tray (see col. 7, lines 65-68). The socket is configured to mate with an elongated fastener, e.g. 76. The fastener has a head or crown nut, e.g. 89, that is biased against a shoulder 81 of a bone anchor 78 that encircles the fastener.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (4,673,407; cited by Applicant).

Martin disclose the claimed invention except for explicitly reciting a stem length in the range of about 2 mm to about 6 mm and a fastener length in the range of about 5 mm to about 15 mm. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected any desired stem and

Art Unit: 3733

fastener length, including, for example, the claimed ranges of about 2 mm to about 6 mm and of about 5 mm to about 15 mm, respectively, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 46, 47 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (4,673,407; cited by Applicant) in view of Klawitter et al. (4,000,525).

Martin disclose the claimed invention except for the inlay of porous bone ingrowth material. Klawitter et al. also disclose a tibial implant 10 and teach providing an inlay 18 of porous bone ingrowth material to create a secure bond between the implant and natural bone "by favorably affecting bone tissue ingrowth" (see the sole figure and col. 1, lines 34-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the tibial implant of Martin with a porous inlay, in view of Klawitter et al., in order to create a secure bond between the implant and natural bone by allowing for favorable bone tissue ingrowth.

### ***Conclusion***

The prior art made of record by Applicant and not relied upon is considered pertinent to applicant's disclosure. For example, the following references cited by Applicant are noted: FR 2718953, WO 91/06260 (Fig. 6, Sec. A-A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to

Art Unit: 3733

reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER